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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/524,990 03/14/00 ANDINO

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EXAMINER

001095 IM22/0724  
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ART UNIT

PAPER NUMBER

1722

DATE MAILED:

07/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/524,990

Applicant(s)

ANDINO et al.

Examiner

Donald Heckenberg

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1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 26-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-35 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. Claims 26-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method and apparatus, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

2. It is noted that in the transmittal papers of the instant application the Applicant has referenced a provisional application to which priority is claimed. However, Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows: An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

tabs -55- (spec. pg. 8, ln. 10),

protrusions -57- (spec. pg. 8, ln. 26),

tabs -59- (spec. pg. 8, ln. 26)

sprue -134- (spec. pg. 22, ln. 21)

Correction is required.

4. The disclosure is objected to because of the following informalities: The specification contains throughout it the symbol --~~¶~~-- (pgs. 7, 10, 12, 13). It is unclear what this symbol is intended to be, and appears to be a typographical error. Appropriate clarification and/or correction is required.

5. Claims 13-14 and 23-24 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims present only limitations to the light. As no light source is referred to in the apparatus parent claim, the light used is a method limitation and therefore the claims do not limit the apparatus structure.

Claim 15, lines 22, 24, and 29 refer to "said light" which is apparently the "curing light" recited in line 19. For consistency, the terminology "curing light" should be used throughout the claim.

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6. The following is a quotation of the second paragraph of 35

U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 13-14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said curing light" in lines 23-24. There is insufficient antecedent basis for this limitation in the claim. Similarly claims 13-14 refer to the "curing light", for which there is no antecedent basis.

Claims 1, and 13-15, and 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the claiming of a light source for the apparatus. As currently recited, claims 13-14 and 23-24 only recite limitations to the light, and therefore present only method limitations and fail to limit the apparatus defined in the parent claims as noted above in the claim objections.

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to

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point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-4, 13-15, 17-18, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzschmar et al. (US 5,782,460) in view of Portney et al. (US 5,053,171) and Buazza et al. (US 5,989,462).

Kretzschmar et al. teach an ophthalmic lens mold comprising a first mold half (11) having a front side (13) and a back side, the front side defining an optical surface, a second mold half (12) having a front side (14) defining an optical surface, wherein alignment of the first mold half and the second mold half form a mold cavity (15) to form an ophthalmic lens (CL) between the opposing surfaces, wherein the first mold half includes a first section (the portion corresponding to the area above 13) that transmits ultraviolet curing light (3) from the back of the mold half to the front of the mold to an area enclosed by an outermost circumference of the ophthalmic lens, a first section, and a second section (21) that blocks the UV curing light, the second section disposed as such that it

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prevents the curing light incident to the back of the mold half from passing to an area that extend radially outward of a boundary of the circumference.

Kretzschmar et al. fails to teach the first and second sections to be co-molded thermoplastic material including polymethylmethacrylate and butadiene. Kretzschmar et al. also fail to teach the use of collimated light.

Portney et al. teaches an apparatus for manufacture of ophthalmic lenses wherein the UV curing light (30) is prevented from reaching areas of the molding surface through the use of a hazy filter (see col. 3, ln. 67 - col. 4, ln. 9). The reference Buazza et al. teaches that a hazy filter is co-molded from different thermoplastic materials (col. 73, lns. 16-27). Portney et al. further teach the use of collimated light for the curing of the lens material (col. 3, lns. 41-42).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar et al. as such to have used a co-molded thermoplastic material for the first and second sections as suggested by Portney et al. because this would be a suitable alternative for preventing the UV curing light from reaching the outer-periphery of the molding material and further would have resulted in the first and section comprising just simply one



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piece. It further would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar et al. to have used collimated light because this is a suitable light for the molding of ophthalmic lenses as suggested by Portney et al.

Regarding the use of the particular thermoplastics polymethylmethacrylate for the first section and polymethylmethacrylate and butadiene for the second section, would have been obvious to one skilled in the art because these are well-known in the art as suitable thermoplastics that would act as alternatives to the teaching of Buazza et al. of a hazy filter comprising polyethylene and bisphenol (see Buazza et al. col. 73, lns. 22-27).

12. Claims 5-6, 9-11, 16, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzschmar et al. modified by Portney et al. and Buazza et al. as applied to claims 1-4, 13-15, 17-18, and 23-24 above, and further in view of Doke et al. (US 6,071,111).

Kretzschmar et al., Portney et al., and Buazza et al. disclose the apparatus as described above. Kretzschmar et al., Portney et al., and Buazza et al. fail to teach the first optical surface to be convex on the first surface (forming the

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optical surface) with a concave surface on the back side and a uniform thickness between the front side and back side.

Kretzschmar et al., Portney et al., and Buazza et al. also fail to teach the first mold half and second mold half to include a plurality protrusions extending forward from the front side to bear on the other mold half so that the mold halves form a cavity.

Doke et al. teach a lens molding apparatus wherein a first mold half (4) comprises a first section with a front convex optical forming surface and a back concave surface with a substantially uniform thickness therebetween (12), and a second section (10) extending from the front side to the back side. Doke et al. further teach the apparatus to comprise protrusions and an annular collar (18 and 26) on the two mold halves to align the two halves and form the molding cavity (see col. 8, lns. 61-63).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar et al., Portney et al., and Buazza et al. as such to have used a first mold half having a convex optical forming surface and a back concave surface with a substantially uniform thickness therebetween because this is a suitable mold construction in forming contact lenses as

suggested by Doke et al. It further would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar et al., Portney et al., and Buazza et al. as such to have used protrusions and an annular collar on the mold halves like the ones taught by Doke et al. because this would aid in the alignment of the mold halves in forming the molding cavity.

Regarding the use of a plurality of protrusions, as noted above Doke et al. teach the use of a protrusion structure. Therefore the use of multiple protrusions would be an obvious modification to one of ordinary skill in the art because this would further aid in the alignment of the mold halves. Normally the duplication of known parts for multiplied effect is of no patentable significance unless it can be shown that there is a new and unexpected result. See *In re Harza*, 124 USPQ 378 (CCPA 960); *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11 (CA7 1977).

13. Claims 7-8, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzschmar et al. modified by Portney et al., Buazza et al., and Doke et al. as applied to claims 1-6, 9-11, 13-18, 20-21, and 23-24 above, and further in view of Friske et al. (US 5,254,000).

Kretzschmar et al., Portney et al., Buazza et al., and Doke et al. disclose the apparatus as described above. Kretzschmar et al., Portney et al., Buazza et al., and Doke et al. fail to teach the first section of the first mold half to further include at least one tab extending radially outward from the center section into the second section.

Friske et al. teach a lens molding apparatus wherein the first mold halve used tabs (32) extending from the center section for the purpose of securing the mold members together (see col. 3, ln. 62 - col. 4, ln. 2).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar et al., Portney et al., Buazza et al., and Doke et al. as such to have used tabs extending from the first section into the second section because these tabs could be used in securing the mold members together as suggested by Friske et al.

14. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzschmar et al., modified by Portney et al., and Buazza et al., as applied to claims 1-4, 13-15, 17-18, and 23-24 above, and further in view of Fogarty (US 5,160,749).

Kretzschmar et al., Portney et al., and Buazza et al., disclose the apparatus as describe above. Kretzschmar et al., Portney et al., and Buazza et al., fail to teach the second mold half to include a back side and a first and second section.

Fogarty teaches a lens mold wherein the first and second mold halves both comprise first and second sides, as well as first and second sections (see fig. 5).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kretzschmar et al., Portney et al., and Buazza et al. as such to have had the first and second mold halves both comprise back sides and first and second sections because this is a suitable design for a lens mold as taught by Fogarty.

15. The following references are cited of interest as being pertinent to the instant application:

Cook et al. (US 4,701,288) teaches the use of a mask to block curing light for the creation of an edge in lens molding.

Bawa (US 4,702,574) teaches a contact lens mold using UV curing light.

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Bawa et al. (US 4,732,715) teaches a contact lens mold wherein selected parts of the mold a block from receiving the curing light by a single piece first mold half.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nam Nguyen, can be reached at (703) 308-3322. The official fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718, and the unofficial fax phone number is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Donald Heckenberg  
July 20, 2001

  
NAM NGUYEN  
SUPERVISORY PATENT EXAMINER  
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